

REMARKS

In the foregoing amendments, the limitations of claims 2, 4, 10 and 14 were inserted into claim 13. Claim 13 was further amended by defining an epoxy-modified acrylic elastomer including a modifying group in an amount of 1 to 40% by weight, the modifying group being an epoxy group. These latter limitations were included in previously presented claim 7 and 8 and are described in applicant's specification disclosure. Claims 2-10 and 14 were canceled in the foregoing amendments, while claims 1 and 12 were previously canceled.

The foregoing amendments were made to clarify what was already implied in applicant's claims and these amendments are not narrowing amendments and were not made for reasons substantially related to patentability presented. Claims 1 and 13 remain pending in the application for consideration by the examiner.

Claims 2-11, 13, and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. patent No. 5,714,573 of Randall *et al.* (Randall) in view of U.S. patent No. 5,804,654 of Lo *et al.* (Lo). Applicant respectfully submits that the teachings of Randall and Lo do not disclose or suggest the inventions defined in claim 11 and 13 within the meaning of 35 U.S.C. §103 for at least the following reasons.

Present claim 13 defines an annealed, heat-resistant molded article comprising a crystalline biodegradable resin composition obtained by annealing a molded composition *consisting of*:

100 parts by weight of an aliphatic polyester including at least one of polylactic acid and polybutylene succinate;

3 to 90 parts by weight of an epoxy-modified acrylic elastomer including a modifying group in an amount of 1 to 40% by weight, the modifying group being an epoxy group; and

0.1 to 50 parts by weight of polytetrafluoroethylene, the polytetrafluoroethylene being acrylic-modified,

wherein the annealing is carried out at a temperature higher than a glass transition temperature of the aliphatic polyester by at least 15°C.

The Official action acknowledged that the teachings of Randall fail to teach the addition of acrylic modified polytetrafluoroethylene (PTFE). The Official action concluded that one having ordinary skill in the art would have been motivated by the teachings of Lo to add the acrylic modified PTFE powders, as allegedly proposed by Lo, to the composition proposed by Randall.

The term "consisting of" in present claim 13 limits the crystalline biodegradable resin composition obtained by annealing a molded composition to only the ingredients and structures that appear in the claim after the term "consisting of." *Ex parte Davis*, 80 U.S.P.Q. (BNA) 448, 450 (Pat. Off. Bd. App. 1948). See *Georgia-Pacific Corp. v. U. S. Gypsum Co.*, 195 F.3d 1322, 1327 (Fed. Cir. 1999); 2 CHISUM, note 60, § 8.06[1][b]; 2 PETER D. ROSENBERG, PATENT LAW FUNDAMENTALS § 14.05[2] (1984). Thus, the crystalline biodegradable resin composition obtained by annealing a molded composition in claim 13 is limited to the aliphatic polyester, epoxy-modified acrylic elastomer including 1 to 40% by weight of an epoxy modifying group and PTFE that is annealed at a temperature higher than a glass transition temperature of the aliphatic polyester by at least 15°C as defined therein.

Applicant respectfully submits that it could not have been obvious to one of ordinary skill in the art to add an isolated component from the teachings of Lo, such as PTFE, into the completely different composition as proposed by Randall so as to arrive at the presently claimed invention. For example, while the teachings of Randall allegedly proposed a polylactide-based polymer and an epoxy-modified acrylic elastomer, the composition proposed by Lo has none of

these components. Why then would one of ordinary skill in the art insert an isolated component from the teachings of Lo, such as PTFE, into the teachings of Randall, when neither teaching remotely contemplates or suggests such a combination? Namely, the presently claimed invention is directed to an improvement in heat resistance, while the teachings of Randall are concerned with an improvement in impact resistance and the teachings of Lo are concerned with fire resistant improvement in various properties, such as, tensile elongation or impact strength. There is no suggestion or motivation to lead one of ordinary skill in the art to add only the PTFE from Lo into the composition proposed by Randall based on the inventions described in Randall and Lo.

It is well established in patent law that there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination or modification. That knowledge cannot come from the applicant's invention itself. *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); *In re Geiger*, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1147, 227 USPQ 543, 551 (Fed. Cir. 1985). Since there is no reason or suggestion in the cited teachings for addition of only the PTFE proposed by Lo into the composition proposed by Randall, applicant respectfully submits that such a combination cannot and would have not been obvious to one of ordinary skill in the art.

Furthermore, if one of ordinary skill in the art allegedly combined the teachings of Randall and Lo, such a combination should include the addition of the styrene polymer and fire retardant, which are required in Lo, to the composition proposed by Randall. However, the styrene polymer and fire retardant, which are required in Lo, are excluded from the presently claimed crystalline biodegradable resin composition obtained by annealing a molded composition by the term "consisting of" in claim 13. References cannot be properly modified if

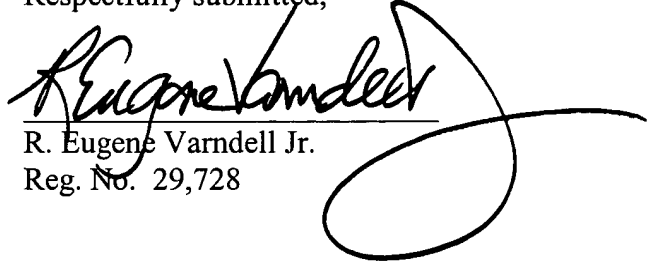
the effect would be to destroy the invention on which the referenced patent is based. *Ex parte Hartmann*, 186 USPQ 366 (P.T.O.Bd.Ap. 1974); *Ex parte Thompson*, 184 USPQ 558 (P.T.O.Bd.Ap. 1974). See also *In re Rosen* 213 USPQ 347 (CCPA 1982); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Removing either the styrene polymer or the fire retardant from the teachings of Lo would destroy the invention therein. On the other hand, the presently claimed crystalline biodegradable resin composition obtained by annealing a molded composition does not "consists of" either the styrene polymer or fire retardant required by Lo. In other words, the styrene polymer or fire retardant required by Lo are excluded from the presently claimed invention. Since removing the polystyrene polymer or the fire retardant from the teachings of Lo would destroy the invention therein and these ingredients of Lo are excluded from the presently claimed invention, applicant respectfully submits that it is impossible for the combination of Lo and Randall to disclose or suggest the invention defined in claim 13 within the meaning of 35 U.S.C. §103.

For least the foregoing reasons, applicant respectfully submits that the presently claimed inventions are patently distinguishable from the teachings of Randall and Lo within the meaning of 35 U.S.C. §103. Therefore, applicant respectfully requests that the examiner reconsider and withdraw the rejection of claims 2-11, 13 and 14 over Randall and Lo as set forth in the outstanding Office action.

Based on the above, a formal allowance of claims 11 and 13 is respectfully requested. While it is believed that all the claims in this application are in condition for allowance, should the examiner have any comments or questions, it is respectfully requested that the undersigned be telephoned at the below listed number to resolve any outstanding issues.

In the event this paper is not timely filed, applicant hereby petitions for an appropriate extension of time. The fee therefor, as well as any other fees which become due, may be charged to our deposit account No. 50-1147.

Respectfully submitted,



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